Dec 15th 82 Submitted on printed argument on behalf of Plff in error — No Counsel for defendant in error —

Mr Justice Miller

SUPREME COURT OF THE UNITED STATES.

No. ~~249~~. 1865.79.

MATTHIAS B. WRIGHT AND JOHN CONNER, PLAINTIFFS IN ERROR,

vs.

MOSES BALES.

IN ERROR TO THE CIRCUIT COURT UNITED STATES FOR THE SOUTHERN DISTRICT OF OHIO.

GEO. S. GIDEON, printer, 511 Ninth street, Washington, D. C.

Affirmed —

Justice Mayne

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Gideon, Print.

At a special and adjourned term of the circuit court of the United States for the seventh circuit and southern district of Ohio, begun and held at the court-house in the city of Cincinnati, on the third Tuesday, being the twenty-first day of February, in the year of our Lord one thousand eight hundred and sixty, and of the independence of the United States the eighty-fourth.

Present, the Honorable Humphrey H. Leavitt, one of the judges of said court. Among others, the following proceedings were had, to wit:

MATTHIAS B. WRIGHT and JOHN CONNER vs. MOSES BALES. } 1,201. Tres. on Case.

Be it remembered, that heretofore, to wit, on the 23d day of May, in the year of our Lord one thousand eight hundred and fifty-nine, came the said plaintiff, by his attorney, and sued out of the clerk's office of said court a certain writ of summons ad respondendum against the said defendants, which is in the words and figures following, to wit:

UNITED STATES OF AMERICA,
Southern District of Ohio, ss.

The President of the United States of America to the Marshal of the Southern district of Ohio, greeting:

You are hereby commanded to summon Moses Bales, citizen of and resident in the State of Ohio, if he be found in your district, to be and appear in the circuit court of the United States for the southern district of Ohio aforesaid, at Cincinnati, on the first Tuesday in the month of June, 1859, to answer unto Matthias B. Wright and John Conner, citizens of and residents in the State of Ohio, of a plea of trespass on the case, damages $10,000 00, and have you then and there this writ.

Witness the Honorable Roger B. Taney, Chief Justice of the United States, this 23d day of May, A. D. 1859, and in the 83d year of the independence of the United States of America.

Attest: JNO. McLEAN, JR., [SEAL.]
Clerk.

Endorse't.

On the back of said writ is the following endorsement, to wit:

Suit brought to recover damages for the infringement of a patent granted to Abraham Marquiss, Ezra Marquiss, Charles

Marquiss, and Charles Emerson, February 19th, 1856, for an improvement in the *mode* of draining ploughs.

Assigned to Robert Reed, David Selsor, William Creighton, Peter W. Taylor, and J. M. Linson, and by them assigned to plaintiffs, September, 1858. Damages $10,000 00.

LEE & FISHER,
Pl'ff's Att'ys.

And on the first Tuesday of June, in the year of our Lord one thousand eight hundred and fifty-nine, the foregoing writ of summons was duly returned by the marshal aforesaid, with his proceedings endorsed thereon, as also the acknowledgment of Elias Straley as security for all costs, and which are clothed in the words and figures as follows, to wit:

Return.

I served the within named Moses Bales, personally, by handing him a certified copy of the within, May 27, '59.

LEWIS W. SAFFORD, *U. S. Marshal.*
By E. McCORMACK, *Deputy.*

Acknow. of Security for Costs.

Also, Elias Straley acknowledges himself security for all costs for which the plaintiff may be liable in this suit. See precipe.

Dec'n.

And now here, to wit, on the thirty-first day of May, in the year last aforesaid, came the plaintiff, by his attorney, and filed his certain declaration in the foregoing case, clothed in the words and figures as follows, to wit:

Circuit Court of the United States for the Seventh circuit and Southern district of Ohio—April Term, A. D. 1859.

MATTHIAS B. WRIGHT and JOHN CONNER
vs.
MOSES BALES.
} Trespass on the Case.

The plaintiffs, Matthias B. Wright and John Conner, comes and complains of the defendant, Moses Bales, in a plea of trespass on the case, for that whereas Abraham Marquiss, Ezra Marquiss, Charles Marquiss, and Charles Emerson, before and at the time of the making of the letters-patent, and of the committing the grievances by the said defendant hereinafter next mentioned, were the original and first inventors of a certain new and useful improvement in the *mode* of draining ploughs, to wit, at Monticello, in the State of Illinois, to wit, in the district aforesaid; and thereupon, heretofore, to wit, on the nineteenth day of February, A. D. 1856, at the city of Washington, to wit, in the district

aforesaid, certain letters-patent under the hand of the Secretary of the Interior of the United States, with the seal of the Patent Office of the United States thereto affixed, countersigned by the Commissioner of Patents of the United States, bearing date the day and year last aforesaid, were granted to the said Abraham, Ezra, and Charles Marquiss, and Charles Emerson, (which letters-patent, or a duly authenticated copy thereof, the plaintiffs now bring into court,) whereby was granted and secured to the said patentees, their heirs, administrators, or assigns, for the term of fourteen years from said 19th day of February, A. D. 1856, the full and exclusive right and liberty of making, constructing, using, and vending to others to be used, the said invention and improvement, a full and exact description of which, with the mode of constructing and applying the same, is set forth in the written specification or description of the said patentees in the words of the said patentees, filed in the Patent Office of the United States, before the granting of said letters-patent, and made part of the same, as by reference to the aforesaid specification or description (here brought into court as aforesaid) will more fully and at large appear. The plaintiffs further say, that said invention and improvement so patented was new and useful; that the said patentees were, all of them, at the time of their application for said patent, citizens of the United States; that they were the original and first inventors of said invention and improvement so patented, and that the same was not known or used before their said invention, and was not in public use, or on sale, with their consent or allowance, for more than two years before their application for said letters-patent. The plaintiff further says, that afterwards, to wit, on the eighteenth day of June, A. D. 1858, the aforesaid patentee, by their written assignment of the date last aforesaid, for a valuable consideration therein mentioned, assigned to Robert Reed, David Selser, William Creighton, Peter W. Taylor, and Jesse M. Luisan, all their right, title, and interest in said invention secured by the aforesaid letters-patent, for, to and in the county of Madison, in the State of Ohio, except the farms of Robert Armstrong, and Jesse, Matthew, and John Rea.

The plaintiffs further say, that afterwards, to wit, on the day of September, A. D. 1858, the said Robert Reed, David Selsor, William Creighton, Peter W. Taylor, and Jesse M. Luisan, by their written assignments of the date last aforesaid, for a valuable consideration therein mentioned, assigned to plaintiffs all their right, title and interest in said invention, secured by the aforesaid letters-patent and assignment for, to, and in the county of Madison, in the State of Ohio, except the farms of Robert Armstrong and Jesse, Matthew, and John Rea, and excepting always the right of said Reed, Selsor, Creighton, Taylor, and Luisan, to make and use said improvement upon their several farms respect-

ively. The plaintiffs say, that both of the foregoing assignments were duly recorded in the Patent Office of the United States, (certified copies of said assignments from said Patent Office being now to the court here shown.) The plaintiffs further say, that they have heretofore made, constructed, used and vended to others to be used, said invention and improvement to their great advantage and profit, to wit, at the district aforesaid. Yet the said defendant, well knowing the premises, but contriving and wrongfully intending to injure the said plaintiffs, and to deprive them of the profits, benefits, and advantage which they might, and otherwise would have derived and acquired from the making, constructing, using, vending to others to be used the said invention and improvement, after the making of said letters-patent, and of the assignment last above mentioned, and within the said term of years in the said letters-patent mentioned, to wit, on the first day of October, A. D. 1858, at the county of Madison, as conveyed to the plaintiffs as aforesaid, to wit, in the district aforesaid, and on divers other days and times between that day and the commencement of this suit, unlawfully and unjustly, against the will of said plaintiffs, and without the leave or license of the said plaintiffs, did make and construct a large number, to wit, two hundred draining ploughs, having the improved mole invented by, and patented to said Abraham, Ezra, and Charles Marquiss, and Charles Emerson, in imitation of said invention, in breach of said letters-patent, and in violation and infringement of the exclusive right thereto, so as aforesaid acquired by the plaintiffs, and contrary to the form of the statutes in such case made and provided, whereby the said plaintiffs, assignees as aforesaid, have been greatly injured and deprived of a great part of the profits and advantages which they might, and otherwise would have derived and acquired from the said invention, to wit, at the district aforesaid; and also for that whereas the said Abraham Marquiss, Ezra Marquiss, Charles Marquiss, and Charles Emerson, before and at the time of the making of the letters-patent, and of the committing the grievances by the said defendant hereinafter next mentioned, were the original and first inventors of a certain new and useful improvement in the mole of *driving* ploughs, to wit, at Monticello, in the State of Illinois, to wit, in the district aforesaid; and thereupon, heretofore, to wit, on the nineteenth day of February, A. D. 1856, at the city of Washington, to wit, in the district aforesaid, certain letters-patent under the hand of the Secretary of the Interior of the United States, with the seal of the Patent Office of the United States thereto affixed, countersigned by the Commissioner of Patents of the United States, bearing date the day and year last aforesaid, were granted to the said Abraham, Ezra, and Charles Marquiss, and Charles Emerson, (which letters-patent, or a duly authenticated copy thereof, the plaintiffs now bring into

court,) whereby was granted and secured to the said Abraham, Ezra and Charles Marquiss, and Charles Emerson, their heirs, administrators or assigns, for the term of fourteen years from said 19th day of February, A. D. 1856, the full and exclusive right and liberty of making, constructing, using, and vending to others to be used, the said invention and improvement, a full and exact description of which, with the mode of constructing and applying the same, is set forth in the written specification or description of the said patentees, in the words of the said patentees, filed in the Patent Office of the United States, before the granting of said letters-patent, and made part of the same, as by reference to the aforesaid secification or description, (here brought into court as aforesaid,) will more fully and at large appear. The plaintiffs further say, that said invention and improvement so patented was new and useful; that the said patentees were, all of them, at the time of their application for said patent, citizens of the United States; that they were the original and first inventors of said invention and improvement so patented, and that the same was not known or used before his said invention, and was not in public use or on sale with their consent or allowance for more than two years before their application for said letters-patent.

The plaintiffs further say, that afterwards, to wit, on the eighteenth day of June, A. D. 1858, the aforesaid patentees, by their written assignment of the date last aforesaid, for a valuable consideration, therein mentioned, assigned to Robert Reed, David Selson, William Creighton, Peter W. Taylor, and J. M. Linsan, all their right, title, and interest in said invention, as secured by said letters patent as aforesaid, for, to, and in the county of Madison, in the State of Ohio, excepting the farms of Robert Armstrong and Jesse, Matthew and John Rea, which assignment was duly recorded in the Patent Office (a certified copy of the same from said office being now to the court here shown). The plaintiffs further say, that afterwards, to wit, on the day of September, A. D. 1858, the said Robert Reed, David Selsor, William Creighton, Peter W. Taylor, and J. M. Linsan, all their right, title, and interest in said invention secured by the aforesaid letters patent and assignment, for, to, and in the county of Madison, in the State of Ohio, except the farms of Robert Armstrong and Jesse, Matthew and John Rea, and excepting always the right of said Reed, Selsor, Creighton, Taylor, and Linsan to make and use said improvement upon their several farms, respectively; which assignment was duly recorded in the Patent Office (a certified copy of the same from said office being now to the court here shown). The plaintiffs further say, that they have heretofore made, constructed, used, and vended to others to be used, said invention and improvement, to their great advantage and profit, to wit, at the district aforesaid. Yet the said defendant, well knowing the premises, but further

contriving and wrongfully intending to injure the said plaintiffs and to deprive them of the profits, benefit, and advantage which they might and otherwise would have derived and acquired from the making, constructing, using, vending to others to be used, the said invention and improvement, after the making of said letters patent and of the assignment last above mentioned, and within the said term of years in the said letters patent mentioned, afterwards, to wit, on the first day of October, A. D. 1858, at the county of Madison, as conveyed to plaintiffs as aforesaid, to wit, in the district aforesaid, and on divers other days and times between that day and the commencement of this suit, unlawfully and unjustly, against the will of said plaintiffs, and without the leave or license of the said plaintiffs, did vend to others, to be used, a large number, to wit, two hundred draining ploughs, having the improved mole invented by and patented to Abraham, Ezra, and Charles Marquiss, and Charles Emerson, as aforesaid, in imitation of said invention, in breach of said letters patent and in violation and infringement of the exclusive right thereto so as aforesaid acquired by the plaintiffs, and contrary to the form of the statutes in such case made and provided, whereby the said plaintiffs' assignees as aforesaid have been greatly injured and deprived of a great part of the profits and advantages which they might and otherwise would have derived and acquired from the said invention, to wit, at the district aforesaid, to the actual damage of the plaintiffs ten thousand dollars; and therefore they sue, by their attorneys, Lee & Fisher. And on the twenty-fourth day of June,

O. B. K. 343. in the year last aforesaid, "On motion of the defendant, by his attorney, the default for plea herein is set aside, and leave given the said defendant to plead forthwith, and plea filed. And on the twenty-fourth day of June, in the year last aforesaid, came the defendants, by their attorney, and filed their certain plea, clothed in the words and figures as follows to wit:

Plea.

U. S. Circuit Court for the Southern district of Ohio.

MOSES BALES
ads. } No. 1,201.
MATTHIAS B. WRIGHT and JOHN CONNER.

And the defendant, for plea, says he is not guilty of the premises set forth in the plaintiffs' declaration; of this they put themselves upon the country, and the plaintiffs do the like.

CHARLES FOX,
Att'y for Def't.

And on the twenty-eighth day of June, in the year last aforesaid,

O. B. K. 346. "On motion of the defendants, by their attorney, it is ordered that this case stand continued at their (the de-

fendants') costs; and, on motion of the plaintiffs, it is ordered that said costs, taxed at $, be paid by the said defendants within ten days, and in default thereof, that execution issue therefor. And now, here, to wit, on the twenty-eighth day of June, in the
O. B. K. 346. year last aforesaid, "On motion of the defendants, by their attorneys, it is ordered that this case stand continued at their (the defendants') costs; and, on motion of the plaintiffs, it is ordered that said costs, taxed at $, be paid by the said defendants within ten days, and in default thereof, that execution issue therefor. And on the eighteenth day of November,
O. B. K. 412. in the year last aforesaid, "On application of defendant, by his attorney, it is ordered that this case stand continued until next December term, at the costs of said defendant, as to this term; and execution is awarded therefor. And on the thirty-
O. B. K. 440. first day of December, in the year last aforesaid, "On, motion of defendant, by his attorney, it is ordered by the court that this case stand continued until next February term, at said defendant's costs, as to this term; and it is further ordered that said costs be paid within ten days, and in default thereof, that execution issue therefor. And now, here, to wit, on the twenty-fifth day of February, in the term of February, in the year of our
O. B. K. 478. Lord one thousand eight hundred and sixty, "Came the parties, by their attorney; and thereupon came a jury, to wit, James Sims, jr., E. D. Patton, John D. Clarkson, Thomas McLean, Charles Lyle, John F. Mitchell, L. L. Laflin, Bart Smith, Andrew Ross, William Garrett, T. H. Griffin, and E. T. Cox, who were duly empanelled and sworn well and truly to try the issue joined between the parties in this cause; and the evidence not being concluded, the court adjourned the jury until Monday morning next, at half-past nine o'clock, to which time this cause is continued. And on the twenty-seventh day of February, in the term
O. B. K. 479. and year last before said, again came the parties, by their attorneys, and also the jury heretofore empanelled and sworn herein; and the evidence not being concluded, the court adjourned the jury until to-morrow morning at 9½ o'cock, to which time this cause is continued. And on the twenty-eighth day of
O. B. K. 480. February, in the term and year last aforesaid, "Again came the parties, by their attorneys, and the jurors heretofore empanelled and sworn herein; and the arguments of counsel not being finished, the court adjourned the jury until half-past nine o'clock to-morrow morning, to which time this cause is continued. And now, here, to wit, on the twenty-ninth day of
O. B. K. 482. February, in the year last aforesaid, "Came the parties, by their attorneys, and also the jurors heretofore empanelled and sworn herein; and the evidence and arguments of counsel being concluded, and the jury having heard the charge of the court, retired to their room, in charge of an officer of this court,

to deliberate upon their verdict. And on the first day of March, O. B. K. 482. in the year last aforesaid, "Came again the parties, by their attorneys, and also the jurors heretofore empanelled and sworn in this cause, who upon their oaths do say that the said defendant is not guilty in manner and form as the said plaintiff hath complained against him. And now, here, to wit, on the twenty-second day of March, in the term of February and year last O. B. K. 494. aforesaid, "This cause came on to be heard upon the motion of said plaintiffs to set aside the verdict, and for a new trial, and was argued by counsel; and upon consideration thereof, the court does overrule the same. It is therefore considered that said defendant go hence without day and recover of said plaintiffs his costs in this behalf expended, taxed at $; and execution is awarded therefor. And on the same day, in the O. B. K. 494. term and year last aforesaid, "Came the plaintiffs, by their attorneys, and presented a bill of exceptions to the charge of the court, which was signed, sealed, and ordered to be made a part of the record in this cause, and which bill of exceptions is in the words and figures as follows, to wit:

Bill of Exceptions.

Cir. Court U. S. South'n Dist't of Ohio.

MATTHIAS B. WRIGHT and JOHN CONNER
vs.
MOSES BALES.

Be it remembered, that upon the trial of this cause the plaintiffs, to sustain the issue on their part, offered in evidence the patent granted to Abraham Marquiss, Ezra Marquiss, Charles Marquiss and Charles Emerson, on February 19th, A. D. 1856, and hereto appended, marked "A," and made part of this bill, and also the assignment of said patentees to Robert Reed, David Selsor, William Creighton, Peter W. Taylor and J. M. Linson, dated June 18th, 1856, and recorded in the Patent Office of the United States May 27th, 1859, and hereto appended, marked "B;" and also the assignment of said Reed Selsor, Creighton, and Taylor and Linson, to plaintiffs, dated September, 1858, and hereto appended, marked "C," and recorded in the Patent Office, May 27th, 1859; and having proved by one George H. Knight, that the aforesaid patent specifications were sufficiently certain and definite to enable a mechanic to make said patented invention, in the opinion of said witness, and that said witness was familiar with mechanism, introduced upon the stand, as a witness, William Bonan, who testified that the defendant told him that he had made and sold in Madison county, Ohio, eight moles for ploughs of the same shape and pattern with that exhibited to the witness and produced and shown to the jury; that witness had visited, last spring, the shop of de-

fendant, in Madison county, Ohio, and had there seen several such moles in process of construction. Plaintiffs then proved by the aforesaid George H. Knight, as an expert, and by others, that the aforesaid mole testified to and identified by said Bonam was identical in its principle and mode of operation with the mole described and patented in the aforesaid patent granted to Marquiss and Emerson, and that said patented invention was useful, in the opinion of the witnesses. Plaintiffs' counsel thereupon offered the plaintiff, Matthias B. Wright, as a witness on his own behalf, claiming that he was a competent witness in his own behalf, under the statutes and laws of the State of Ohio, for any purpose; but the defendant objected to the competency of said witness, and claimed that he was incompetent because he was a party to the record and one of plaintiffs, which objection the court sustained and refused to permit the said Matthias B. Wright, plaintiff, to testify. To which ruling of the court the plaintiffs excepted, and prayed that this, their bill of exceptions, be signed and sealed and ordered to be recorded; which is done and ordered accordingly; and thereupon the plaintiffs rested their case.

Whereupon the defendant, to sustain the issue on his part, offered in evidence the deposition of A. B. Dickenson, hereto appended, marked D. To the admission of which deposition the plaintiffs objected, because no notice had been filed attacking the novelty of said patent, although it was admitted that the notices appearing in the record had been served upon plaintiffs' counsel more than thirty days previous to the trial; but plaintiffs claimed said notices "should have been filed previous to the trial to permit evidence of want of novelty to be given under them;" but the court overruled said objection and permitted the notices to be filed at once, and held that previous service thereof was sufficient without filing to justify proof of want of novelty under said notices. To which ruling the plaintiffs excepted, and prayed that this, their bill of exceptions, be signed and sealed and ordered to be recorded; which is done and ordered accordingly.

Plaintiffs further objected to the admission of said depositions of said A. B. Dickenson, for the reasons contained in the written exceptions filed thereto in February 20th, 1860, and contained in the paper marked "E," hereto attached; but the court overruled said exceptions and permitted said deposition to be read in evidence. To which ruling the plaintiffs excepted, and prayed that this his bill of exceptions be signed and sealed and ordered to be recorded; which is done and ordered accordingly; and defendant having introduced much evidence tending to prove the want of utility of said patented invention, and the want of similarity between the patented invention and that made and sold by defendant; also books, *modes*, mole-ploughs, and other evidence tending to show want of novelty; also the evidence of experts familiar with me-

chanics, who testified that there was no utility in the patented plough; that there was no novelty in the inventions claimed; that the plough of defendant was not an infringement of the patented plough; that the two moles were not identical in principle or construction—rested his case.

Whereupon the plaintiffs, in rebuttal, read in evidence another deposition of said A. B. Dickenson, hereto appended, marked "F;" and also produced what they claimed was a model of the said Dickenson plough, and introduced evidence in rebuttal to show that none of the structures proved to exist previous to the patented invention resembled it in any material degree; and thereupon the plaintiffs asked the court to charge the jury as follows, among other things, to wit:

"If the jury find the Dickinson mole to be the same as plaintiffs', yet, if said mole was used only for Dickenson's private purpose twenty-two years ago, and was abandoned by him twenty years ago, and no mole was subsequently constructed upon the same principle until the invention of plaintiffs, it cannot affect the plaintiffs' patent." Which charge the court refused to give; and the court stated to the jury, in substance, that it was for them to decide whether the groove or cavity in the bottom of the mole described by Dickenson in his deposition, and represented by the model exhibited to the jury, is the same or substantially like the cavity described in the specification of the Marquiss and Emerson patent, and claimed by them as a part of their invention. If the jury find this identity between the two moles, to that extent, the novelty of the patentee's improvement is disproved, and the patent so far invalidated, unless the circumstances under which the Dickinson mole was known and used were such as not to affect the claim of novelty by Marquiss and Emerson.

The plaintiffs' counsel insist that the Dickinson mole was invented some twenty-two years since, and after being used by himself for two years, was discarded as useless; and that there is no evidence that has since been used by any one, and that these facts do not impeach the patentee's claim to the novelty of his invention; and a decision of the Supreme Court of the United States is referred to and relied on as sustaining this view. The case cited was a suit brought for an infringement of the plaintiffs' right under a patent for a safe, of which he claimed to be the first and original inventor. It was proved that a safe had been constructed and used by an individual in the city of New York some years prior to the date of the plaintiff's patent, which was identical with the one described in his specifications; but it also appeared that the safe had only been used by one person, and had been lost sight of and forgotten for several years before the date of the pl'ffs' patent. The Supreme Court held, that such prior knowledge and use of this safe did not impair or defeat the plaintiff's patent for

his invention, notwithstanding the identity of the two safes. This decision was by some regarded at the time as an innovation upon the law as previously understood. But the law, as settled by the rulings of the Supreme Court, is authoritative on this court, and is fully recognised as furnishing a rule for its decisions; and the present case must be controlled by the case referred to, if the facts bring it within the principle of that case. On this point my mind is not wholly free from doubt. I incline, however, to the opinion, that the cases are to be distinguished, and that the ruling of the Supreme Court does not bring this case within the operation of the rule settled by that court. It appears that the mole referred to by Dickenson was publicly used by him on his farm in the State of New York for at least two years, and that during that time he made it known to many persons and explained to them its use. If the jury find these facts to be proved, it will be evidence of prior knowledge and use, so far as Marquiss and Emerson claim the cavity in their mole as a part of their invention. It will not, however, affect their claim to the tail or elongation of their mole as a new and useful improvement. And if the jury believe the identity of the two moles as to the cavity is made out, but that the tail or elongation of the Marquiss and Emerson mole is new and useful in making subterraneous drains, it will be competent for them to find the fact of infringement against the defendant, and award damages to that extent. In this connection, it is proper to remark to the jury, that if they believe that Dickenson had *an* miniature conception of an improved mole, and his use of the one to which he refers was merely experimental, and that his experiments were not successful, and that his mole did not accomplish the end proposed, and was finally abandoned by him and not used by others, such knowledge and use will not affect the validity of the Marquiss & Emerson patent. To which rulings of the court, and its refusal to charge as requested, as well as to all the aforesaid rulings of the court, the plaintiffs excepted, and prayed that their bill of exceptions may be signed and sealed, and made a part of the record; which is done accordingly.

H. H. LEAVITT. [SEAL.]

Exhibit A.

The U. States Patent Office to all persons to whom these presents shall come, greeting:

This is to certify that the annexed is a true copy, from the records of this office, of letters-patent issued to A. Marquiss, E. Marquiss, C. Marquiss, and C. Emerson, February 19, 1856.

In testimony whereof, I, William D. Bishop, Commissioner of Patents, have caused the seal of the Patent Office to be hereunto affixed, this 15th day of June, in the year

[SEAL.] of our Lord one thousand eight hundred and fifty-nine, and of the independence of the United States the eighty-third.

WM. D. BISHOP.

The United States of America to all to whom these Letters-patent shall come:

No. 14,287.

Whereas Abraham Marquiss, Ezra Marquiss, and Charles Marquiss, of Monticello, Ill., and Charles Emerson, of Decatur, Ills., have alleged that they have invented a new and useful improvements in the mole of draining ploughs, which they state has not been known or used before their application, have made oath that they are citizens of the United States; that they do verily believe that they are the original and first inventors or discoverers of the said improvement, and that the same hath not, to the best of their knowledge and belief, been previously known or used, have paid into the treasury of the United States the sum of thirty dollars, and presented a petition to the Commissioner of Patents, signifying a desire of obtaining an exclusive property in the said improvement, and praying that a patent may be granted for that purpose: These are, therefore, to grant, according to law, to the said Abraham Marquiss, Ezra Marquiss, Charles Marquiss, and Charles Emerson, their heirs, administrators, or assigns, for the term of four teen years from the nineteenth day of February, one thousand eight hundred and fifty-six, the full and exclusive right and liberty of making, constructing, using, and vending to others to be used, the said improvement, a description whereof is given in the words of the said Marquisses and Emerson, in the schedule hereunto annexed, and is made part of these presents.

In testimony whereof, I have caused these letters to be made patent, and the seal of the Patent Office has been hereunto affixed. Given under my hand, at the city of Washington, this nineteenth day of February, in the [SEAL.] year of our Lord one thousand eight hundred and fifty-six, and of the independence of the United States of America the eightieth.

ROBERT McCLELLAND,
Secretary of the Interior.

Countersigned and sealed with the seal of the Patent Office.

C. MASON,
Commissioner of Patents.

The schedule referred to in these letters, and making part of the same:

To all whom it may concern:

Be it known that we, Abraham Marquiss, Ezra Marquiss, and

Charles Marquiss, of Monticello, in the county of Pratt, and Charles Emerson, of Decatur, in the county Macon and State of Illinois, have invented sundry new and useful improvements in the mole-plough, or implement for forming subterranean perforations for draining purposes; and we do hereby declare that the following is a full and exact description thereof, reference being had to the accompanying drawings, making a part of this specification.

Fig. 1, being a top view of our improved mole-plough.

Fig. 2, a vertical, longitudinal section in the line x x of Fig. 1.

Fig. 3, a side view of said implement, placed in a proper position for the application thereto of power to carry its mole into the earth.

Fig. 4, a rear view of the mole and a portion of its supporting shank.

Fig. 5, a view of the under side of said mole; and

Fig. 6, a vertical, longitudinal section of the same.

Similar letters represent corresponding parts in all the figures.

Our first improvement consists in giving such a shape to the mole A that its action upon the earthy substance, in forming a perforation, will be such as to densely compress the sides and top of said perforation, and leave the bottom of said perforation comparatively uncompressed. The dense compression of the top and sides of the perforation formed by our improved mole, prevents the water from entering at those parts, and thereby enables them to retain their shape for any length of time, whilst the uncompressed state of the bottom of said perforation enables the water to enter it freely.

The second feature of our invention consists in the addition of a tail to the said mole, of such a shape and placed in such a position that it will serve the purpose of closing up the slit formed by the flat shank (B) of the mole during its forward movement, and also the additional purpose of guiding and directing the mole to the surface of the earth, as soon as the beam E, to which the shank of the mole is secured, is relieved from its fastenings within in its supporting frame, so as to allow said beam to turn freely upon its axis.

The shape of the mole A is clearly represented in Figs. 4, 5, and 6 of the accompanying drawings, viz: it is brought to a sharp cutting edge or point at its forward end, and thence its outer surface flares upwards and outwards towards the rear, until its back terminates in the round, tapering tail (a) which extends some distance beyond the sides of the mole. The under side of the said mole is hollowed out from a point a short distance in the rear of its cutting edge or point, back to the rear extremity of its sides; and the rear extremities of said sides of the mole are bevelled off to cutting edges.

The mole A is securely fastened to the lower end of a flat,

sharped-edged shank B, which descends from a strong beam E, that is secured within a suitable frame, in such a manner that it can be rigidly secured in any desired position, or may be allowed to turn freely on its axis. It will be perceived that the shape of the mole A is such that its forward movement within the earth will cause it to form a perforation whose top and sides will be densely compressed and whose bottom will be left almost entirely uncompressed. The tail (a) of the mole extends far enough back of the rear edge of the shank B to close up the slit cut by said shank and make a smooth and hard surface at the top of the perforation formed by the mole. As soon as the beam E is relieved from its fastening wedges, whilst forward motion is being imparted to the implement the said pointed tail of the mole, acting in conjunction with the pressure exerted upon the body of the mole, will lead said mole upwards to the surface during the forward movement of but a few feet.

It is believed by the undersigned that the sides and top of the perforation formed by our improved form of mole are so densely compressed that the water will not penetrate them, and that the said perforation will remain perfect in shape for any length of time. The water being allowed to freely enter the bottom of the perforation made by our improved form of mole, said perforation will serve its purpose much more perfectly than perforations formed by implements of such a shape that they act with equal pressure at top, bottom, and sides, in forming said perforations.

The frame before referred to is composed of the side-pieces, or runners, C C, and the cross-pieces D D, which are permanently framed to each other.

Pairs of uprights, G G, rise from the side-pieces C C of said frame, which have their upper extremities respectively connected to each other by the cap-pieces H H. The yokes thus formed by the uprights G G, and their caps H H, receive the ends of the strong beam E, to which the coulter F and the mole-shank B are rigidly secured by any suitable method of fastening. By means of wedges J J, the beam E may be securely confined within the aforesaid yokes, substantially as represented in the drawings, or by any other suitable method that will admit of its being readily fastened and unfastened. When unfastened, the said beam E can turn freely in its receiving yokes.

The mole-shank B projects some distance above the beam E, and its front edges is acted by the brace K, whose front end bears against the middle cross-piece D of the frame. The ends of the side-pieces C C of the mole-plough frame are curved, or have an upward inclination, for the purpose of enabling said frame to pass freely over the surface of the ground.

By placing our improved mole-plough in the position represented in Fig. 3, and causing it to be drawn forwards, the mole A will

immediately bury itself in the earth to as great a depth as the length of the shank will permit, and will maintain that depth as the implement is carried forwards, and perforations may be formed at any desired depth below the surface of the earth with our mole-plough, by adjusting the depth of the mole-shank B below the beam E.

We are aware that mole-ploughs for forming subterranean drains have been used, and therefore we wish it to be understood that we do not claim the principle of forming underground drains by the use of such implements; but what we do claim as our invention, and desire to secure by letters patent, is, the peculiar shape of the mole A, which enables its forward movement to form a subterranean perforation, whose top *whose* and sides will be smoothly and densely compressed, and whose bottom will be left almost entirely uncompressed, substantially in the manner and for the purpose herein set forth.

We also claim the tail (a) of the mole, such a shape and position that it will serve to close up the slit cut by the mole-shank B, in forming a perforation, and also serve to lead the mole upwards to the surface of the ground, as soon as the beam E is allowed to turn on its axis, substantially as herein set forth.

The above machine is intended to underdrain wet lands. Given under our hands this 27th day of December, 1855.

ABRAHAM MARQUISS,
EZRA MARQUISS,
CHARLES MARQUISS,
CHAS. EMERSON.

Witnesses: A. G. T. BRYEN,
H. C. M. COMAS.

[*For drawing referred to, see original, page* 26.]

Exhibit B.

Whereas we, Abraham Marquiss, Ezra Marquiss, and Charles Marquiss, of Monticello, Piatt county, Illinois, and Charles Emerson, of Decatur, Macon county, Illinois, did obtain letters patent for certain improvements in the mole of draining ploughs, which letters patent bear date on the 19th day of February, 1856; and whereas Robert Reed, David Selsor, William Creighton and Peter W. Taylor and J. M. Linson, *is* desirous of obtaining an interest therein:

Now this indenture witnesseth, that for and in consideration of the sum of three hundred dollars to us in hand paid, the receipt of which is hereby acknowledged, we have assigned, sold and set apart, and by these presents do assign, sell and set apart, all the right, title, and interest which we have in said invention, as secured to us by said letters patent, for, to, and in county of Madison, State of Ohio, except the farms of Robert Armstrong, Jesse

Rea, Matthew Rea and John Rea, and in no other place whatever: the same to be held and enjoyed by the said Robert Reed, David Selsor, William Creighton, Peter W. Taylor and J. M. Lenson, for their own use behoof, and for the use and behoof of their legal representatives, to the full term for which said letters patent is or may be granted, as fully and entirely as the same would have been held by and enjoyed by us, had not this assignment and sale have been made.

Witness our hands and seals, this 18th day of June, 1858.

ABRAHAM MARQUISS, [SEAL.]
EZRA MARQUISS, [SEAL.]
CHARLES MARQUISS, [SEAL.]
CHARLES EMERSON. [SEAL.]

Rec'd and rec'd May 27, 1859.

JOHN KINNEY.

Exhibit C.

Know all men by these presents, that we, Robert Reed, David Selsor, Wm. H. Creighton, Peter W. Taylor and Jesse M. Linson, in consideration of the sum of two thousand dollars, to us in hand paid by M. B. Wright and John Conner, we do hereby remise, release, and forever quit-claim to the said M. B. Wright and John Conner, all our right and interest whatever which we have in certain improvements in the mole of draining ploughs, secured to Abraham Marquiss, Ezra Marquiss, Charles Marquiss and Charles Emmerson, of Decatur, Macon county, Illinois, by letters patent, dated 19th February, 1856, and conveyed by said patentees to us, by deed dated June 18th, A. D. 1858; except, always, the right of said Reed, Selsor, Creighton, Taylor, and Linsom to make and use said improvements upon their several farms respectively.

As witness our hands and seals, this day of September, A. D. 1858.

ROBERT REED, [SEAL.]
DAVID SELSOR, [SEAL.]
W. H CREIGHTON, [SEAL.]
P. W. TAYLOR, [SEAL.]
JESSE M. LINSOM. [SEAL.]

Rec'd and rec'd May 27, 1859.

Exhibit D, referred to in Bill of Exceptions.

Circuit Court of the United States for the Southern district of Ohio.

MATHIAS B. WRIGHT and JOHN CONNER vs. MOSES BALES. } Northern district of New York.

STATE OF NEW YORK,
Steuben County, ss.

Moses Bales, of Fairfield township, Madison county, State of Ohio, being duly sworn, deposes and says, that he is the defendant in the above entitled cause, and that he is advised by his counsel, and verily believes, that the testimony of Andrew B. Dickenson, at present of the town of Hornby, in the county of Steuben and State of New York, farmer, is material and necessary for this deponent in the prosecution of such cause; that the said Andrew B. Dickenson lives at the town of Hornby, in the county of Steuben and State of New York, more than one hundred miles from the city of Cincinnati, in the State of Ohio, where the court at which this deponent expects this cause will be tried is appointed by law to be held. And this deponent further says, that the above named plaintiffs reside in the county of Fayette, in the State of Ohio, more than one hundred miles from Corning, Steuben county, New York, the place where the examination of the said witness is expected to be taken; and that Lee and Fisher, the attorneys for the said plaintiffs, reside at the said city of Cincinnati, more than one hundred miles from Corning aforesaid.

MOSES BALES.

Subscribed and sworn before me, January 18th, 1860.
T. A. JOHNSON,
Justice Supreme Court.

Circuit Court for the United States, for the Southern district of Ohio.

STATE OF NEW YORK,
Steuben County, ss.

MATTHIAS B. WRIGHT and JOHN CONNER
vs.
MOSES BALES.

Let Andrew B. Dickinson, the witness named in the foregoing affidavit, be examined de bene esse before me, accordingly, at five o'clock in the afternoon, on the 18th day of January, A. D. 1860, at my office, in Corning, Steuben county, New York.

T. A. JOHNSON,
One of the Justices of the Supreme Court of the 7th Judicial District of the State of New York, of which the County of Steuben forms a part.

Be it remembered, that on the eighteenth day of January, one thousand eight hundred and sixty, at the hour of five o'clock in the afternoon, at my office, in Corning, Steuben county, New York, Moses Bales personally appeared before me, Thomas A. Johnston, one of the justices of the seventh judicial district of the supreme

court of the State of New York, of which said district the county of Steuben forms a part, and made oath that he, the said Moses Bales, was defendant in a suit then depending in the circuit court of the United States for the southern district of Ohio, wherein Matthias B. Wright and John Conner were plaintiffs, and the said Moses Bales was defendant; that the testimony of Andrew B. Dickinson, of the town of Hornby, in the county of Steuben and State of New York, farmer, was material and necessary for him, the said defendant, in the prosecution of such suit, and that he, the said Andrew B. Dickenson, lived at the town of Hornby, in the county of Steuben, in the State of New York, more than one hundred miles from the city of Cincinnati, in the State of Ohio, where the court at which he, the said defendant, expected the said cause would be tried, was appointed by law to be held; that the said plaintiffs resided at the county of Fayette, in the State of Ohio, more than one hundred miles from Corning aforesaid, and that Lee and Fisher, the attorneys for the said plaintiff, resided at the said city of Cincinnati, more than one hundred miles from Corning aforesaid. And the said defendant, Moses Bales, requested me, that the said Andrew B. Dickenson might be examined, according to the directions of the act of Congress in such case made and provided.

Whereupon I ordered, that the said Andrew B. Dickenson should be examined de bene esse at my office, in Corning, Steuben county, New York, at which place I reside, and keep an office, on the eighteenth day of January, A. D. 1860, at five o'clock in the afternoon, the said Moses Bales appearing before me at the time and place last aforesaid. I have proceeded, therefore, at my office at Corning aforesaid, with the said examination.

And the said Andrew B. Dickenson, being then and there by me carefully examined, and cautioned, and duly sworn to testify the whole truth, and nothing but the truth, saith: I reside in the town of Hornby, Steuben county, New York; my business is farming; I have been engaged in that business forty years; I have been engaged in the business of farming in Hornby thirty-seven years. During most of the time my farm has consisted of about three thousand acres; my age is fifty-seven years; I have paid particular attention to the subject of under-draining; I have given particular attention to this subject for upwards of thirty years; about 22 or 23 years ago my attention was turned to some cheaper mode of draining than by digging a ditch; I have had made for my own use for this purpose several kind of mole ploughs; one of these, made for me about twenty-two years ago, was constructed as follows: the mole was of wrought iron, about thirty inches long, about six inches wide at the bottom of the back end, and tapering to a point at the forward end. The bottom of the mole was grooved out from the back to the forward end, so as to run on the edges instead of

the whole bottomed surface, which construction prevented the whole surface of the ground under the mole from being pressed hard; the mole was about four or five inches high at the hind end, and descending to a point at the forward end.

In general description the mole was three-cornered, three-sided, and wedge-shaped on the upper surfaces. The bottom surface was grooved, as before stated, lengthwise of the mole.

The edges upon which the mole ran were hollowed in the middle, so that where the mole rested on a plane surface it rested on the point and heel.

In practical operation it was started in an open ditch at a depth of about two feet, and drawn by a sufficient team of oxen or horses, and the depth gauged by a wheel under the beam.

This construction of the mole, as before described, presses the earth upward and outward, but not downward, except on the edges on which the mole run.

There was a coulter attached to the point of the mole, and fastened to the beam of sufficient width to give it strength, and about three-fourths of an inch thick; the earth closed after it. The wooden model hereto attached, marked "A, B, D," shows the shape of the mole as constructed and used by me.

(The witness here produced the model, which is hereto attached by me, and is made part of the deposition of the witness.)

I used this kind of mole about two years next succeeding its first construction, and have made known the construction and utility thereof to a large number of persons for the last eight or ten years.

(Signed) A. B. DICKENSON.

I, Thomas A. Johnson, one of the justices of the supreme court of the State of New York, duly elected, commissioned, and qualified as such justice, and authorized by law to take depositions and other testimony to be used in courts of justice, hereby certify that Andrew B. Dickenson, having personally appeared before me, and as hereinbefore certified, at my office aforesaid, and after being carefully examined, cautioned, and duly sworn, deposed as aforesaid; that the said deposition was reduced to writing by me, and was signed by said Andrew B. Dickenson in my presence. I further certify that said Andrew B. Dickenson is personally known to me to be the person he hereinbefore purports to be.

In testimony whereof, I have hereto set my hand, this eighteenth day of January, one thousand eight hundred and sixty, at my office in the village of Corning. I further certify that I have no seal of office as such justice.

THOMAS A. JOHNSON.

STATE OF NEW YORK,
City and County of Albany, ss.

OFFICE OF THE SECRETARY OF STATE.

I, David R. Floyd Jones, secretary of State in and for the State of New York, do hereby certify that Thomas A. Johnson, of Corning, Steuben county, State of New York, was on the 18th day of January, 1860, and is now a justice of the supreme court of the State of New York, duly elected, commissioned, and qualified as such, and authorized by law to take depositions, and that full faith and credit should be given to his official acts.

In testimony whereof, I have caused the seal of my office to be hereunto affixed, this sixth day of Feb'y, A. D. 1860.

D. R. FLOYD JONES. [SEAL.]

Exhibit E.

We except to this dep'n, and ask the court to rule it out—

1st. Because it is not properly enveloped and divided and superscribed.

2d. Because the dep'n does not appear to have been reduced to writing in the presence of the witness.

3d. Because it is not properly certified.

4th. Because there is no sufficient proof of the official character of the officer who took this dep'n.

July 20, 1860.

LEE & FISHER,
Att'ys for Wright & Conner, Pl'ffs.

We also except to the within deposition, because it does not appear that the officer taking it retained the same until the same was sealed up by him.

Feb'y 21st, 1860.

LEE & FISHER,
Att'ys for Pl'ffs.

Exhibit F.

Deposition of a witness taken before me, Charles H. Thurman, a notary public within and for Steuben county, New York, at the residence of A. B. Dickenson, at Hornby, in said county and State, on the 26th day of January, A. D. 1860, to be used in evidence on the part of the plaintiffs in a certain suit at law pending in the circuit court of the United States within and for the seventh circuit and southern district of Ohio, wherein Matthias B. Wright and John Conner are plaintiffs, and Moses Bales is defendant.

Andrew B. Dickenson, of Hornby, Steuben county, and State of New York, aged fifty-seven years, or thereabouts, being produced

and sworn on behalf of the plaintiffs, deposeth and saith, as follows:

I reside in the town of Hornby, Steuben county, New York; my business is farming; I have been engaged in farming in the town of Hornby for thirty-seven years; during the most of the time my farm has consisted of about three thousand acres; I have paid particular attention to the subject of under-draining for upwards of thirty years; about twenty-two or twenty-three years ago, I turned my attention to some cheaper mode of draining, than by digging a ditch; I have had made for my own use for this purpose several kinds of mole ploughs; one of these, made for me about twenty-two years ago, was constructed as follows: the mole was of wrought iron, about thirty inches long, about six inches wide at the bottom of the back end, and tapering to a point at the forward end; the bottom of the mole was grooved out from the back to the forward end, so as to run on the edges, instead of the whole bottom surface, which construction prevented the whole surface of the ground under the mole from being pressed hard; the mole was about four or five inches high at the hind end, and *discerning* to a point at the forward end; in general description, the mole was then cornered, three-sided and wedge-shaped on the two upper surfaces; the bottom surface was grooved, as above stated, lengthwise of the mole; the edges upon which the mole run was then hollowed in the middle, so that when the mole rested on a plane surface, it rested on the point and heel; in practical operation, it was started in an open ditch at a depth of about one and a half to two feet, and drawn by four pair of strong, substantial, well-fed oxen, and the depth gauged by a wheel under the brace; this construction of the mole, as before described, presses the earth outwards and upwards, but not downward, except on the edges on which the mole runs; there was a coulter attached to the point of the mole, and fastened to the beam; the coulter was about four inches wide and about five-eighths of an inch thick; there was a hind brace attached to the rear of the mole, and fastened to the beam parallel to the coulter, and of the same width and thickness; between these two were two cross-beams about two and a half inches wide, and of the same thickness as the coulter. The drawing hereto attached, marked Exhibit "A," is a drawing of the whole plough in question. "A" is the beam running nearly on the surface of the ground, gauged by the wheel; "B" is the mole; "C" the coulter; "D" the hind brace; "E E" the cross-braces; "F" one of the handles; "G" a rear view of the mole; "H" point of the coulter projecting before the mole; "K K K" the surface of the ground; "M" the wheel by which the depth is gauged. The wooden block hereto attached, marked "A, B, D," is a model of the shape of the mole to which I have referred above. I used this kind of mole about two years next after its construction. I have tried several experiments in the matter of

mole draining, of which the one above set forth was one. I have endeavored to get the best form of a mole. The result of my experiments and experience is, that a round mole pressing the bottom, as well as the top and sides, is equally good with the one I have referred to above. I have used the round-bottom mole occasionally for twelve years past, but may have used the grooved mole, possibly, a little during that time for experiment in different soils. This plough may be lying around somewhere now, but I cannot tell where; I may be able to find it, but cannot now tell whether I can or not.

And further deponent saith not.

A. B. DICKENSON.

UNITED STATES OF AMERICA,
State of New York, County of Steuben, ss.

I, Charles H. Thurman, a notary public within and for the county and State aforesaid, duly commissioned and sworn, do hereby certify that on the 26th day of January, A. D. 1860, at the residence of A. B. Dickenson, in Hornby, in said county and State, being the time and place specified in the caption of this deposition, before me came personally the above named A. B. Dickenson, who after being carefully examined and cautioned, and sworn to testify the truth, the whole truth, and nothing but the truth in the cause named in the caption of this deposition, did, in my presence, subscribe the foregoing deposition after the same had been reduced to writing by me in the presence of the witnesses; that I am not of counsel or attorney to either of the parties in the cause aforesaid, or in any manner whatsoever interested in the event thereof; that no notice of the time and place of the taking of this deposition was given to the said defendant, his attorney or agent, because neither of them was then within one hundred miles of said Hornby, the place of taking the same, and that the said A. B. Dickenson lives and resides at a greater distance than one hundred miles from the city of Cincinnati, in the southern district of Ohio, the place of trial of said action, and that said deposition was retained by me until the same was sealed up by me, and transmitted to the court in which said cause is pending. All of which is certified by me, this 26th day of January, A. D. 1860.

Witness my hand and notarial seal.

CHARLES H. THURMAN,
Notary Public in and for
Steuben County, New York.

[SEAL.]

Exhibit "A," attached to foregoing Deposition and referred to.

Referred to by witnesses in the annexed deposition and attached by me.

C. H. THURMAN,
Notary Public.

[*For drawing see original, page* 39.]

UNITED STATES OF AMERICA,
Southern District of Ohio, ss.

I, John McLean, jr., clerk of the circuit court of the United States, within and for the seventh judicial circuit and southern district of Ohio, do hereby certify that the foregoing is a true and accurate transcript of the proceedings had in the case of Matthias B. Wright and John Conner vs. Moses Bales, together with the bill of exceptions and exhibits thereto attached and referred to therein, as also the deposition of A. B. Dickenson, as the same remain on file in my office.

In testimony whereof, I hereunto subscribe my name and affix the seal of said court at Cincinnati, this 24th day of [SEAL.] April, A. D. 1860, and the 84th year of the independence of the United States of America.

Attest: JNO. McLEAN, JR.

Writ of Error.

Supreme Court of the United States.

UNITED STATES OF AMERICA, *ss.*

The President of the United States of America, to the honorable the judges of the circuit court of the United States for the seventh circuit and southern district of Ohio, greeting:

Because in the record and proceedings, and also in the rendition of a judgment in a plea, which is in the said circuit court before you, between Matthias B. Wright and John Conner, plaintiffs, and Moses Bales, defendant, a manifest error hath happened, to the great damage of the said plaintiffs, as by their complaint appears; and it being fit that the error, if any there hath been, should be duly corrected and full and speedy justice done to the parties aforesaid in this behalf, you are hereby commanded, if judgment be therein given, that then, under your seal, distinctly and openly, you send the record and proceedings aforesaid, with all things concerning the same, to the Supreme Court of the United States, together with this writ, so that you have the same at the city of Washington on the first Monday in the month of December next, in the said Supreme Court, then and there to be held, that the record and proceedings aforesaid being inspected, the said Supreme Court may cause further to be done therein to correct that error, what of right and according to the law and custom of the United States should be done.

Witness the Honorable Roger B. Taney, Chief Justice of the said Supreme Court of the United States, this second day

[SEAL.] of April, in the year of our Lord one thousand eight hundred and sixty, and of the independence of the United States of America the eighty-fourth.

Attest: JNO. McLEAN, JR.,
Clerk of the Circuit Court of the United States for the Seventh Circuit and Southern district of Ohio.

Allowed by

H. H. LEAVITT,
Judge of the Cir. Court of the U. S. for the Southern district of Ohio.

Filed April 2, 1860.

Citation.

THE UNITED STATES OF AMERICA,
Supreme Court of the United States.

To Moses Bales, greeting:

Whereas Matthias B. Wright and John Conner obtained the allowance of our writ of error to the judges of the circuit court of the United States for the seventh circuit and southern district of Ohio directed, to remove into the said Supreme Court, to be holden at the city of Washington, on the first Monday in the month of December next, the record of a certain plaint, process, proceedings, and judgment in an action of trespass on the case, wherein you the said Moses Bales in that action lately recovered against the said Matthias B. Wright and John Conner a judgment and costs, as by the said record in the said circuit court of the United States for the seventh circuit and southern district of Ohio remaining appears, in which said record and proceedings, and also in the rendition of the judgment thereupon, manifest error hath intervened, as by the said Matthias B. Wright and John Conner we are informed, and our said writ of error granted, issued and allowed as aforesaid, for the purpose of correcting the errors aforesaid alleged, if any there be: you are, therefore, hereby commanded and cited to be and appear before the judges of the Supreme Court, at the city of Washington, at the next term of said court, to be holden on the first Monday in the month of December next, to have the errors aforesaid corrected, and the judgment of our said Supreme Court thereupon.

Witness the Honorable Roger B. Taney, Chief Justice of the United States of America, this second day of April, in the year of our Lord one thousand eight hundred and sixty, and of the independence of the United States of America the 84th.

H. H. LEAVITT,
Judge of the Cir. Court of the U. S. for the Southern Dist. of Ohio.

Read a copy of this citation April 4th, 1860.

R. M. CORNIVE,
Att'y for Moses Bales.

Know all men by these presents, that we, Willis Hays and Coleman Hays, are held and firmly bound unto Moses Bales in the penal sum of one thousand dollars, to the payment of which well and truly to be made, we do, by these presents, jointly and severally bind ourselves, our heirs, executors, and administrators. Sealed with our seals, and dated this 1st day of March, A. D. 1860.

The condition of this obligation is such, that whereas the said Mathias B. Wright and John Conner obtained an allowance of a writ of error upon a certain judgment in the circuit court of the United States, seventh circuit and southern district of Ohio, at the February term thereof, A. D. 1860, in favor of Moses Bales, in an action of trespass on the case brought by Mathias B. Wright and John Conner against the said Moses Bales, wherein a judgment was rendered in favor of the said Moses Bales against the said Wright and Conner:

Now if the said Wright and Conner shall pay the condemnation money and costs, in case the said judgment of said circuit court shall be affirmed by the Supreme Court of the United States, in whole or in part, then the above obligation shall be void; otherwise in full force and virtue in law.

WILLIS HAYS. [SEAL.]
COALMAN HAYS. [SEAL.]

Approved by

JNO. McLEAN, JR.,
Clerk, &c.

Approved by

H. H. LEAVITT,
Judge, &c.

Supreme Court U. S.—Dec. Term, A. D. 1860.

WRIGHT & CONNER
vs.
MOSES BALES.

Matthias B. Wright and John Conner, plaintiffs in error, come and say, that in the record and proceedings aforesaid there is manifest error in this, to wit:

1st. The circuit court below erred in refusing to allow the plaintiff, Matthias B. Wright, to testify as a witness in the cause.

2d. Said court erred in admitting the deposition of A. B. Dickenson in evidence.

3d. Said court erred in refusing to charge the jury as requested by plaintiffs.

4th. Said court erred in its charge as given to the jury.

5th. Said judgment should have been for plaintiffs instead of defendants.

6th. Other errors apparent on the record.

Wherefore plaintiffs ask that said judgment be reversed, and that they be restored to all things lost thereby.

GEORGE M. LEE & SAM'L S. FISHER,
Att'ys for Pl'ffs in Error.

Filed 3d December, 1860.

1301

Wright & Conner
vs
Motes Bales

1303

SUPREME COURT, U. S.

ERROR TO

CIRCUIT COURT, U. S.

AT CINCINNATI.

LEE & FISHER,
for Plaintiff in Error.

1305

SUPREME COURT, U. S.

MATTHIAS B. WRIGHT and JOHN CONNER *versus* MOSES BALES. } *Error to Circuit Court, U. S., Southern District of Ohio.*

The Court below refused to permit the plaintiff Wright to testify, at the trial, as a witness in his own behalf. To this ruling he excepted, and this is the first point presented by the Record, and the first error we claim.

We maintain that—

A PARTY TO THE SUIT IS A COMPETENT WITNESS IN HIS OWN BEHALF IN OHIO.

This case was tried at the February term, A. D. 1860, of the Circuit Court of the United States, sitting at Cincinnati, Ohio; and in the year 1853 the Legislature of the State of Ohio passed a statute entitled, "An Act to establish a Code of Civil Procedure." Section 310 of this Code reads thus: "No person shall be disqualified as a witness in any civil action or proceeding by reason of his interest in the event of the same, as a party or otherwise, or by reason of his conviction of a crime, but such interest or conviction may be shown for the purpose of affecting his credibility." This statute was

in full force in Ohio at the time of this trial; and in all the Ohio courts, except this, the plaintiff would have been allowed to testify without hesitation or objection.

Now, upon what principle is it, that a Federal Court sitting in Ohio presumes to administer to the citizens of Ohio laws not her own? It certainly will not increase the regard of the citizens of any State for the Federal tribunals, to know that laws *foreign* to those made by its citizens are administered and enforced therein. We claim that the Federal Courts of Ohio are Ohio Courts, and just as much bound to administer Ohio laws as any other Courts in the State. The doctrine that the "*lex loci*" shall control the rights of parties, and shall be enforced by all Courts, has been recognized in its fullest extent from the earliest days of English jurisprudence; and no civilized judiciary ever attempted to enforce among any people (except a conquered nation) laws other than those of the particular people and place. The Federal tribunals, and especially the Supreme Court, have strenuously endeavored to produce uniformity between their decisions and those of the Courts of the State where such tribunals were located. They have, therefore, always followed the decisions of the highest State Courts, and the practice of State tribunals, unless they were found not to accord with justice, the Constitution of the United States, or the acts of Congress.

We claim, therefore, if this question were to be decided upon the original principles of justice and law, or the well settled policy and practice of the Federal tribunals, the error would be apparent.

But we consider the question is settled by the act of

1789, and the construction thereof given by this Court. The 34th section of the judiciary act of 1789 provides "that the laws of the several States, except where the Constitution, treaties, or statutes of the United States shall otherwise require or provide, shall be regarded as rules of decision in trials at common law, in the Courts of the United States, in cases where they apply." Now it would seem to require no proof to show that a rule of evidence was "a rule of decision," within the meaning of this act. But this Court has expressly decided that question also. See McNiel *vs.* Holbrook, 12 Pet., p. 84.

This was a suit brought in Georgia, by the endorser against the maker of promissory notes. The statute of Georgia had provided that such notes should be admitted as evidence, without proof of the hand-writing of the assignor thereof. Upon the trial, these notes were permitted, by the Circuit Court in the District of Georgia, to go in evidence under this statute of Georgia, without proof of their endorsement to the plaintiff, and a judgment having been rendered against the defendant below, he assigned this omission to require proof of the endorsement for error.

In deciding the case, Chief Justice Taney says, in speaking of this very 34th section of the act of 1789: "The object of the law of Congress was to make the rules of decisions in the Courts of the United States the same with those of the States, taking care to preserve the rights of the United States by the exceptions contained in the same section. Justice to the citizens of the several States required this to be done; and the natural import of the words used in the act of Congress in-

cludes the *laws in relation to evidence*, as well as the laws in relation to property. We think they are both embraced in it, and as by a law of Georgia the endorsement on these notes was made *prima facie* evidence that they had been so endorsed by the proper party, we think the Circuit Court was bound to regard this law as a rule of evidence."

Again, in case of Sims *vs.* Hundley, 6 How., 1, where the question was, whether a Notary's certificate, made evidence by the statute of Mississippi, was admissible in the Circuit Court of the United States, for Mississippi, Chief Justice Taney again says: "It is true that, upon general principles of commercial law, this certificate would not be admissible. But it is made evidence by the statute of Mississippi, and the rules of evidence prescribed by the statute of a State are always followed by the courts of the United States, when sitting in the State, in commercial cases as well as in others."

These cases are certainly conclusive, but this very question has been met and decided by several Federal judges on the circuit, and among them by Justices Curtis and Nelson. In case of United States *vs.* Dunham, decided by Judge Curtis in the District of Massachusetts, and reported in the Monthly Law Reporter for July, 1859, Judge Curtis admits the evidence of parties to the suit, under a statute of Massachusetts, of the same kind as the Ohio statute, and the learned Judge says: "I consider it to be settled that the State laws of evidence are rules of decision in civil trials at the common law, under the 34th section of the judiciary act."

This same question was decided in the same way by Mr. Justice Nelson, in one of the Districts of New York,

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in the case of United States *vs.* Furnass, and the statute of New York, passed upon by the learned Judge, is the same in substance as the Ohio statute.

The same question is said to have been also so decided by the late Judge Ingersoll, and also by Judge Sprague, but we have not seen these opinions.

Certainly this error is apparent. But it may be said that there was a rule in the Court below, which disqualified this witness. It is only necessary to reply to this, that the Court below could not abrogate or overcome a statute of the State by a regular rule, any better than by a decision. The rule and the ruling stand on the same footing. The Court below could not legislate a statute out of existence by a rule, any more than they could adjudicate it out of existence by a ruling. No notice that the plaintiff would testify as a witness was necessary in the Court below. Section 313 of the Ohio code, which requires such notice, was repealed April 12th, 1858. See section 3rd of the Statute of Ohio, of said date, entitled, "An Act to amend the 313th and 314th sections of the Code of Civil Procedure."

In Smith *vs.* Carrington, 4 Cranch, 62, this Court held, that if evidence were illegally admitted, the Court could not inquire into its weight or importance, but would reverse the judgment; and we suppose the converse of this proposition is equally true, and if evidence be illegally rejected, this Court will not inquire into its importance, but will reverse the judgment.

It is apparent that it would be impossible to show the weight or importance of the plaintiff's evidence, but certainly a party must be presumed to understand his own case. It must also be presumed he would testify

to matters material to his interests. Hence, by the common law he was excluded from testifying at all, for fear that by reason of his interest the materiality of his testimony would outweigh its truth.

It seems to us, in every possible view, the error of the Court is apparent, and that the judgment should be reversed.

II. ERROR IN PERMITTING NOTICES OF SPECIAL MATTER TO BE FILED.

The record shows, in this case, that after the trial began the defendant was permitted to file his notice of special matter, attacking the novelty of the patent, and to give evidence, under said notice, of want of novelty. The notices had been served in due time, but were not filed till after the trial began. Now, we claim a defendant must file his served notices before the trial begins.

What is a notice, in effect, but a special plea? It is substituted for such a plea. See section 15 of the Patent Act, 1836; Evans *vs.* Eaton, 3 W., 454; Wilder *vs.* Gaylord, 1 Blateb, 597; Phelps *vs.* Comstock, 4 McLean, 525.

How can the plaintiff know what he is to meet until the notice is filed? Many notices are often served, but only one filed. How can the plaintiff know on which the defendant relies until it is filed? Certainly it is no part of the issue before the jury unless filed, and until filed. It is then no part of the issue they are at first sworn to try. It is obvious that the notice is just as much an indispensable part of the record as a plea; for questions as to its extent and sufficiency constantly arise. Certainly, then, like a plea, it must be filed be-

fore trial,—and, if not so filed, can not be part of the case tried.

III. THE COURT ERRED IN OVERRULING THE PLAINTIFF'S EXCEPTIONS TO THE *exparte* DEPOSITION OF A. B. DICKINSON.

Plaintiffs excepted to this deposition because it did not appear to have been reduced to writing in the presence of the witness; because it was not properly certified; because there was no sufficient proof of the official character of the officer who took the deposition; and because it did not appear that the deposition was retained by the officer till sealed up.

In Bell *vs.* Morrisson, 1 Peters, 335, this Court held, "The authority to take testimony in this manner being in derogation of the rules of the common law, has always been construed strictly, and therefore it is necessary to establish that all the requisites of the law have been complied with before such testimony is admissible;" and the Court then held a deposition inadmissible because it was not certified to have been reduced to writing by deponent in the presence of the officer. Certainly the same necessity exists that the witness should be present when the deposition is reduced to writing, as that the officer should be, and the act so contemplates.

In this certificate it is not stated that the deponent was present when the officer wrote the deposition. In that it was not stated that the officer was present when the deponent wrote the deposition. Abstractly considered, it would be worse to permit the deponent to be absent when the officer wrote, than to permit the officer to be absent when the deponent wrote.

But this 30th section of the Judiciary Act of 1789, upon which the case of Bell *vs.* Morrisson was based, clearly contemplates that both the deponent and officer shall be present when the deposition is written, and great mischief would probably ensue if the absence of either were permitted, where the law contemplates the adverse party in the suit will always be absent. Certainly both the presence of witness and officer should be required, and the Court erred in holding the contrary.

Again: this 30th section provides that the deposition shall be taken before a judge "not being of counsel or attorney to either of the parties, or interested in the event of the cause." The certificate does not show this fact. For all that appears in the certificate, the officer may have been either counsel or interested in the suit. If not interested, the fact should have appeared, and its omission is fatal. See Harris *vs.* Wall, 7 How., 693.

Again: there was no legal proof of the official character of the officer. The certificate of the Secretary of the State of New York does not identify the Thomas A. Johnson who took these depositions as the same man with him of that name whom the Secretary certifies was Judge; but, if it had thus identified the officer, such a certificate is not evidence in the Federal Courts. It does not verify any paper of which he is the legal custodian, but the certificate undertakes to state a fact, to-wit: that one Thomas A. Johnson was a Judge in New York on a certain day. No act of Congress has made such a statement of the Secretary of the State of New York evidence, nor is it evidence upon any com-

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mon law principle. There was, then, no legal proof of the official character of the officer, and the deposition should have been rejected.

This 30th section also provides that the officer shall retain the deposition until he deliver it to the Court, or mail it. It was never intended that the deposition should pass into the hands of either party before it reached the Court. This retention is not stated in the certificate, and such omission has been held to be fatal. See Shankwiker *vs.* Reading, 4 McLean, 240.

IV. THE COURT ERRED IN CHARGING THE JURY, AND IN REFUSING TO CHARGE THE JURY AS REQUESTED BY THE PLAINTIFFS.

In order to judge of the correctness of the charge of the Court, we must first examine the patent which is made part of this record. This patent, dated February 19th, 1856, grants to Abraham, Ezra, and Charles Marquiss, and Charles Emerson, of Illinois, a "new and useful improvement in the mole of draining plows," which has been assigned to plaintiffs. The plow, or mole, is, with all its attachments, fully shown in the drawings, and its purpose and object is very clearly described in the specifications. It is the design of the patentees to make, by this mole, a subterranean ditch or drain in the earth, three or four feet below the surface, the top and sides of which shall be compressed and closed smoothly, leaving the bottom of the drain loose and open, so that the water can enter it from below and pass off, and thereby drain the surface of the land. The mole is suspended by a beam from above. This beam passes along the surface of the ground, and the mole is attached to it by an iron cutter or shank,

somewhat like the cutter of a surface plow. By drawing forward this beam, in any way, the iron mole burrows into the ground like the natural mole, its namesake, but deeper, and the ditch is formed. The mole is also elongated by its tail, the purpose of which is to close up, from below, the slit in the roof of the ditch, made by the cutter as it passes along.

This is the first patent on a mole plow ever granted by the Government. Marquiss and Emerson are the pioneers in this field. By means of this simple piece of iron, millions of acres of our prairies and low lands have been and are being drained. Numerous junior patents for improvements on this have been issued of late, and a new field is opened in this respect, whereby vast labor is done by means of this mole, which formerly was accomplished by the spade in the hands of men. Its great value and utility is beyond dispute. It is obvious if the surface plow, or any triangular piece of metal, be sunk into the ground and drawn forward, it will leave the top of the ditch open, and will compress all sides alike. Hence, this mole has been so made and arranged, that, suspended as it is from above, and running on its point, it will compress the top and sides of the drain, and leave its bottom open. Before the time of Marquiss and Emerson, the mole plow had been used but little, never being sunk low in the earth, and always leaving the vault of its drain open. The drain was, in consequence, of but little use,—being trampled down by cattle on account of its shallowness and yawning, and soon falling in, because its walls were not compressed so as to sustain it. It was little more or better than the ditch produced by the surface plow, run a lit-

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tle deeper than usual. But Marquiss and Emerson have so modified this old mole, that, unlike the surface plow, it now closes up instead of opening the top, and compresses the sides of the ditch instead of the bottom, as does the surface plow. Its object is exactly the reverse in this respect, both of the surface plow and the old mole.

To illustrate: it upsets the ditch, and does its work upon its top and sides, instead of the bottom,—making an arched or vaulted drain from three to four feet below the surface of the earth, through whose bottom the water filters, while its top and sides are substantially water tight.

The defendant attacked the novelty of this patent, and attempted to prove that the aforesaid A. B. Dickinson had invented and used such a mole as that of Marquiss & Emerson, prior to their invention. The only proof tending to show this were the depositions "D" and "F," attached to the record, of A. B. Dickinson himself. By these depositions it appeared that twenty-two years before the date of the Marquiss & Emerson patent, he had produced a mole plow, which was three-cornered, three-sided, and wedge-shaped, having also a hollow bottom; that Dickinson used this plow for two years, and then abandoned it; that he did not know what had become of it, or where it was. The defendants claimed this plow was the same as that of Marquiss & Emerson. The plaintiffs claimed it was altogether different.

Upon this state of facts the plaintiffs requested the Court to charge the jury, that "If the jury find the Dickinson mole to be the same as plaintiffs', yet if said

mole was used only for Dickinson's private purposes, twenty-two years ago, and was abandoned by him twenty years ago, and no mole was subsequently constructed upon the same principle until the invention of plaintiffs', it can not effect the plaintiffs' patent." This charge the Court refused to give, but charged the jury, in substance, that this Dickinson mole, if the same as plaintiffs', would defeat their patent for want of novelty. The charge of the Judge is long and rambling, and includes a comment upon the case of Gayler *vs.* Wilder, 10 How., 477; but its effect was to negative this request of plaintiffs', and to charge the law to the contrary. We maintain this request was correct, and should have been charged as asked. See Gayler *vs.* Wilder, 10 How., 477.

In the case of the Conner safe, in Gayler *vs.* Wilder, there would appear to have been a continuous use as well as sale of the article, attended, too, with some degree of publicity; for the safe stood and was used in a public office, and then sold,—but in this case the mole was used for experiment, as Dickinson says, and was finally thrown aside, after two years' use, and is now lost. Its rude form shows it to have been merely an experiment, and the fact that it was thrown aside and no other mole made, either by Dickinson or others, proves it was an unsuccessful experiment. It had slept forgotten for twenty years, unknown and without advantage to the public, before this invention.

Nor can there be any knowledge of the Dickinson mole traced to Marquiss & Emerson. Dickinson produced his plow in 1837–8, in New York; and Marquiss produced his in 1856, in Illinois. The parties are

probably six hundred miles apart, and separated, too, by twenty years of time, and are, in fact, strangers. The reason of the doctrine of Gayler *vs.* Wilder is sound beyond question. An invention which has remained immature and unused by the public, or which has been abandoned, is as though it were never made. No benefit arises from it to any one, and never will, and it should not be allowed to defeat an original inventor, who, though junior, has perfected and given to the public the benefit of his labor and skill.

But the decision and reasoning of this Court in Gayler *vs.* Wilder are conclusive on this question. That decision has stood unquestioned for over ten years, and is based upon right. Besides, the Conner safe was a much stronger defense to establish want of novelty than the Dickinson mole. And this Court, having held that the Circuit Court, in that case, was right in charging, "that if Conner had not made his discovery public, but had used it simply for his own private purposes, and it had been finally forgotten and abandoned, such a discovery and use would be no obstacle to the taking out of a patent by Fitzgerald, or those claiming under him, if he be an original, though not the first inventor or discoverer"—must, upon this precedent, hold that the Circuit Court, which here charged fully the converse of that proposition, erred.

V. Again: the Court below seems, in this charge, to have wandered into confusion and error as to the cavity of the plaintiffs' mole and that of Dickinson. The Court was not requested by us to charge anything about the cavity in these two moles. We claimed nothing from it, but it was the duty of the Court, if it saw fit,

to go further than the requests, and to construe the patent generally, to also construe it correctly; and, if the Court failed to construe it rightly, that also was an error. Here the Court charges the jury, *sua sponte*: "If the jury find these facts (Dickinson's facts) to be proved, it will be evidence of prior knowledge and use, so far as Marquiss & Emerson claim the cavity in their mole as a part of their invention. It will not, however, effect their claim to the tail or elongation of this mole, as a new and useful improvement. And if the jury believe the identity of the two moles, as to the cavity, is made out,—but that the tail or elongation of the Marquiss & Emerson mole is new and useful in making subterranean drains, it will be competent for them to find the fact of infringement against the defendants."

Now here is obvious error. The Court tells the jury the patentees claim a hollow mole,—and that, in this claim, they are to be defeated by a prior hollow mole, when, in fact, there never was any such claim in the patent. The first claim of the patent is "the peculiar shape of the mole, 'A,' (shown in the drawings to the patent), which enables its forward movement to form a subterranean drain, whose tops and whose sides will be smoothly and densely compressed, and whose bottom will be left almost entirely uncompressed."

But the Court seems to have thought that in order to leave the bottom of the drain uncompressed, the mole must be hollow, which is not the fact; and, if it was, it is not a fact to be charged by a judge, but one to be proved by evidence. Nor does the patent anywhere attribute the uncompressed bottom of the drain to the

hollowness of the mole, but distinctly says: "The shape of the mole ('A') is such that its forward movement within the earth will cause it to form a perforation whose top and sides will be densely compressed, and whose bottom will be left almost entirely uncompressed." Now, as the mole runs upon its point, with the tail elevated, and as it is suspended from its beam, which is above the ground, it is obvious that the bottom of the drain would be left equally uncompressed, whether the bottom of the mole be hollow or flat, for that bottom never touches the bottom of the drain. The Court, therefore, erred in construing and charging this patent to be for a hollow mole, and in telling the jury that it would be defeated by a prior hollow mole.

VI. But again: the Court, in looking down at the bottom of the drain, and in contemplating the hollowness of the mole, seems to have overlooked the top and sides of the drain altogether. Our claim calls for a mole which not only leaves an uncompressed bottom to its drain, but which makes compressed sides and top. The Court, therefore, should have told the jury that the Dickinson mole, if prior, must be found not only to uncompress the bottom of the drain, but to compress its sides and top.

Now, the Dickinson mole could not do this; but, from its triangular shape and the great width of its cutter, would necessarily leave the top of the drain open and uncompressed. It was necessary for defendants to produce a prior mole, which not only had one quality of ours, but all. It must not only have an uncompressed bottom, but must compress the top and sides.

This the Court forgot, or erroneously stated, and charged the jury that we might be defeated by a prior mole, having one quality of ours instead of all three. This, also, is obvious error.

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